



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,959	01/24/2001	Vern Cunningham	13582	2793

293 7590 06/06/2002

DOWELL & DOWELL PC
SUITE 309
1215 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

CHOI, JACOB Y

ART UNIT PAPER NUMBER

2875

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/767,959	Applicant(s) CUNNINGHAM ET AL.	
	Examiner Jacob Y Choi	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,13 and 14 is/are rejected.
- 7) ☒ Claim(s) 3-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 86, 96, 102, 107 etc. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The drawings figures are replete with the reference sign(s) not mentioned in the description. The drawing figures and specification should be revised carefully in order to comply with 37 CFR 1.84(p)(5).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 3, 4 & 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "wall conduit" in claims 1, 3, 4 & 6 are a relative term which renders the claim indefinite. The term "wall conduit" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "wall conduit" is being used as different structure through out the dependent claims 3, 4 & 6. In claim 3, the "wall conduit" is a vacuum wall valve. In claims 4 & 6, the term "a vacuum system" was not defined by the claim. The structure, which goes to make up the device, must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 13 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakellaris (USPN 4,255,780).

Regarding claim 1, Sakellaris discloses a light (64) powered by an electrical circuit connected to the connection (Figure 2), and a frame (Figure 2, frame structure around the switch member) for housing the light, the frame having an opening (Figure 1) allowing access to the component through the frame, a side (front side) and an aperture

(32a) in the side allowing the light to illuminate a space outside the frame assembly through the aperture.

Note: case law *In re Japikse*, 86 USPQ 70 may be used against Applicant's claim regarding location of an aperture, since Applicant has not disclosed that the particular location of the light solves any stated problem or is for any particular purpose.

Regarding claim 2, Sakellaris discloses the frame houses the electrical circuit.

Regarding claim 13, Sakellaris discloses the wall conduit is a wall outlet or an electrical switch.

Regarding claim 14, Sakellaris discloses a light (64) an electrical circuit (Figure 2) providing electrical energy to the light from a power source (42, 44), a frame (Figure 2, frame structure around the switch member) for mounting around wall conduit and the light inside the frame assembly, the frame comprising a side (front side) and an aperture in the side (32a) allowing the light to illuminate a space outside the frame assembly through the aperture (Figure 2), and a cover plate (46) for covering the frame and for providing access to the components of the wall conduit (Figure 1).

Note: case law *In re Japikse*, 86 USPQ 70 may be used against Applicant's claim regarding location of an aperture, since Applicant has not disclosed that the particular location of the light solves any stated problem or is for any particular purpose.

7. Claims 1, 2, 13 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by A. A. McCarthy (USPN 2,749,428).

Regarding claim 1, A. A. McCarthy discloses a light (62) powered by an electrical circuit (Figure 7) connected to the connection, and a frame (Figure 2) for housing the

Art Unit: 2875

light, the frame having an opening allowing access to the component through the frame (42), a side (front side) and an aperture (area where the light bulb sits) in the side allowing the light to illuminate a space outside the frame assembly through the aperture.

Note: case law *In re Japikse*, 86 USPQ 70 may be used against Applicant's claim regarding location of an aperture, since Applicant has not disclosed that the particular location of the light solves any stated problem or is for any particular purpose.

Regarding claim 2, A. A. McCarthy discloses the frame houses the electrical circuit.

Regarding claim 13, A. A. McCarthy discloses the wall conduit is a wall outlet or an electrical switch.

Regarding claim 14, A. A. McCarthy discloses a light (62) an electrical circuit (Figure 7) providing electrical energy to the light from a power source (72), a frame (Figure 2) for mounting around wall conduit and the light inside the frame assembly, the frame comprising a side (front side) and an aperture in the side (area where the light bulb sits) allowing the light to illuminate a space outside the frame assembly through the aperture, and a cover plate (22) for covering the frame and for providing access to the components of the wall conduit (Figure 3).

Note: case law *In re Japikse*, 86 USPQ 70 may be used against Applicant's claim regarding location of an aperture, since Applicant has not disclosed that the particular location of the light solves any stated problem or is for any particular purpose.

7. Claims 1, 2, 13 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiter et al. (USPN 3,739,226).

Regarding claim 1, Seiter et al. discloses a light (98, 99) powered by an electrical circuit (Figure 2) connected to the connection, and a frame (Figure 2) for housing the light, the frame having an opening allowing access to the component through the frame (light sockets), a side (front side) and an aperture (area where the light bulb sits) in the side allowing the light to illuminate a space outside the frame assembly through the aperture.

Note: case law *In re Japikse*, 86 USPQ 70 may be used against Applicant's claim regarding location of an aperture, since Applicant has not disclosed that the particular location of the light solves any stated problem or is for any particular purpose.

Regarding claim 2, Seiter et al. discloses the frame houses the electrical circuit.

Regarding claim 13, Seiter et al. discloses the wall conduit is a wall outlet or an electrical switch.

Regarding claim 14, Seiter et al. discloses a light (98, 99) an electrical circuit (Figure 2) providing electrical energy to the light from a power source (72), a frame (Figure 2) for mounting around wall conduit and the light inside the frame assembly, the frame comprising a side (front side) and an aperture in the side (area where the light bulb sits) allowing the light to illuminate a space outside the frame assembly through the aperture, and a cover plate (45) for covering the frame and for providing access to the components of the wall conduit (Figure 1).

Note: case law *In re Japikse*, 86 USPQ 70 may be used against Applicant's claim regarding location of an aperture, since Applicant has not disclosed that the particular location of the light solves any stated problem or is for any particular purpose.

Allowable Subject Matter

8. Claims 3-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the claims recite a frame assembly for covering a wall conduit having a connection to electrical power and a component associated with the wall conduit requiring access through the frame assembly, the frame assembly where the wall conduit is a vacuum wall valve. Because none of the reference disclosed the combination with a vacuum wall valve, nor is there any motivation to combine, the claims are deemed patentable over the prior art of record.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jester (USPN 4,514,789) – illuminated light switch plate with LED and oscillator circuit

Nguyen (USPN 5,485,356) – receptacle power indicator

Moreland (USPN 6,000,807) – switch cover plate providing automatic emergency lighting

T. L. Wheeler, Jr (USPN 2,580,056) – electrical lighted wall switch plate

Blackman et al. (USPN 6,010,228) – wireless emergency safety light with sensing means for conventional light switch or plug receptacle


Horwinski (USPN 4,038,582) – internally illuminated switch plate

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y Choi whose telephone number is (703) 308-4792. The examiner can normally be reached on Monday-Friday (9:30-6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-8303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7724.

JC
May 28, 2002


THOMAS M. SEMBER
PRIMARY EXAMINER